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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,787	12/17/2001	Eiichiroh Hosoi	JP920000428US1	1983
26502	7590	02/24/2006	EXAMINER	
IBM CORPORATION IPLAW IQ0A/40-3 1701 NORTH STREET ENDICOTT, NY 13760			JEAN GILLES, JUDE	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/021,787

Applicant(s)

HOSOI, EIICHIROH

Examiner

Jude J. Jean-Gilles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This Action is in regards to the Reply received on 12/08/2005.

#### ***Response to Amendment***

1. This action is responsive to the application filed on 12/08/2005. Claims 1-14 are pending in this application. Claims 1, 4, 6, 9, 12, and 13 were amended. No new claims have been added. Claims 1-14 represent an "electronic mail communicating method, apparatus and system using facsimile communication procedure."

#### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 4, 6, 9, 12, and 13 have been carefully considered, but are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following existing ground of rejection as explained here below. Applicant's substantial amendment (i.e., a method wherein said mail information originates in an electronic mail format... ) to the claims does not affect the scope thereof, and the rejection of the First Office action stays.

The dependent claims stand rejected as articulated in the First Office Action and all objections not addressed in Applicant's response are herein reiterated.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-16** are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshida et al (Yoshida), Patent No. 6,801,546 B1.

Regarding **claim 1**, Yoshida discloses a method for communicating electronic mail data from a sender to a receiver via a network (fig. 1), comprising the steps of:

(a) recognizing a dial number of said receiver corresponding to destination address information attached to said electronic mail data (column 14, lines 37-65; column 18, lines 1-39);

(b) converting said electronic mail data into an image form permitting facsimile communication, wherein said electronic mail data originates in and electronic mail format (column 12, lines 61-67; column 13, lines 1-31); and

(c) initiating a call to said receiver using said recognized dial number and transmitting said electronic mail data converted into said image form to the receiver by facsimile communication procedures, wherein said image form is adapted to be restored into electronic mail data in the electronic mail format (column 23, lines 34-67).

Regarding **claim 2**, Yoshida discloses the method as set forth in claim 1, wherein the step of converting comprises the step of determining a horizontal number of pixels and generating data by linking the data with the horizontal number in a vertical direction according to a specification based on ITU-T Recommendation T-30 (column 14, lines 28-65).

Regarding **claim 3**, Yoshida discloses the method as set forth in claim 2, wherein the step of converting further comprises the step of generating data to be transmitted by using a mail body in which said electronic mail data are recognized to be a series of binary values, a header representing said image form, and a padding for linking the mail body and the header by adjusting line width of the horizontal numbers of pixels. Note that these features are inherent to an electronic mail and are well known in the art.

Regarding **claim 4**, Yoshida discloses an electronic mail communicating method, comprising the steps of:

(a) retrieving mail information stored in a server (fig. 1, item 1-3) to be transmitted over a switched line (fig. 1, item 1-6) from the server wherein said electronic mail data originates in and electronic mail format (column 8, lines 36-67);

(b) selecting a specification of communication needed for communication over the switched line from a network address contained in said mail information (column 17, lines 8-64); and

(c) initiating a call to said switched line using the selected specification of communication, and transmitting said mail information according to facsimile

communication procedures to a receiving apparatus connected via the switched line (column 23, lines 34-67).

Regarding **claim 5**, Yoshida discloses the electronic mail communicating method as set forth in claim 4, wherein the step of retrieving comprises the step of retrieving said mail information with recognition that the mail information is to be transmitted from said network address via said switched line (column 23, lines 34-67; column 17, lines 8-64).

Regarding **claim 6**, Yoshida discloses an electronic mail communicating method, comprising the steps of:

(a) receiving data containing electronic mail information converted into an image form permitting facsimile communication from a sender wherein said electronic mail data originates in and electronic mail format (column 29, lines 20-62);

(b) converting said received data into electronic mail information (column 23, lines 5-65);

(c) analyzing a destination contained in the converted electronic mail information;  
(d) generating reply information to converted electronic mail information (column 23, lines 5-65); and

(e) converting said reply information into said image form and sending the converted reply information to the sender (column 24, lines 8-67).

Regarding **claim 7**, Yoshida discloses the electronic mail communicating method as set forth in claim 6, wherein, if a terminal with a destination corresponding to said analyzed destination is not connected to an internal network, reply information representing absence of any relevant destination is generated (column 34, lines 39-65).

Regarding **claim 8**, Yoshida discloses the electronic mail communicating method as set forth in claim 6, wherein, if received data do not contain electronic mail information, conventional facsimile reception operation takes place (column 34, lines 3-38).

Regarding **claim 9**, Yoshida discloses an electronic mail transmitting apparatus for transmitting electronic mail data to a receiver using a switched line not through the Internet (fig. 1, item 1-6), comprising:

- a communication specification determination unit for determining a specification of communication with said receiver for communication over said switched line based on destination address information for an external network assigned to the electronic mail data (column 23, lines 34-67);

- a conversion unit for converting electronic mail data to be transmitted into a data form for communication over said switched line wherein said electronic mail data originates in and electronic mail format (fig. 3, item 3-10, column 17, 32-51; column 12, lines 61-67; column 13, lines 1-31); and

- a transmission unit for transmitting said electronic mail data converted into said data form by said converting unit, to said receiver in accordance with said specification of communication determined by said communication specification determination unit,

using said switched line, wherein said image form is adapted to be restored into electronic mail data in the electronic mail format (column 17, lines 8-64; column 18, lines 10-64).

Regarding **claim 10**, Yoshida discloses the electronic mail transmitting apparatus as set forth in claim 9, wherein said communication specification determination unit stores in advance correspondence information among destination address information for a network assigned to electronic mail data, a dial number of said receiver and a communication procedure based on ITU-T Recommendation T-30, and determines the specification of communication based on the stored correspondence information (column 14, lines 28-65).

Regarding **claim 11**, Yoshida discloses the electronic mail transmitting apparatus as set forth in claim 9, wherein said conversion unit recognizes data contained in said electronic mail data as a series of binary values, and converts the data form by adjusting line widths. Note that these features are inherent to an electronic mail and are well known in the art.

Regarding **claim 12**, Yoshida discloses an electronic mail transmitting apparatus, comprising:

a mail retrieving unit for retrieving from a server mail information to be transmitted over a switched line wherein said electronic mail data originates in and electronic mail format (column 8, lines 36-67);

a communication specification determination unit for determining a specification of communication for communication over the switched line based on a network



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address contained in said mail information retrieved by said mail retrieving unit (column 17, lines 8-64); and

a transmission unit for initiating a call on said switched line using said specification of communication determined by said communication specification determination unit and transmitting said mail information to a receiving apparatus connected via the switched line by facsimile communication (column 23, lines 34-67).

Regarding **claim 13**, Yoshida discloses a mail receiving apparatus for receiving electronic mail data originating in an electronic mail format that has been converted into a form permitting facsimile communication from a sender via a switched line, comprising:

a receiving unit for receiving data from said sender via said switched line by facsimile communication (column 29, lines 20-62);

a restoring unit for restoring said data received by said receiving unit into electronic mail data (column 23, lines 5-65); and

a transferring unit for transferring said electronic mail data restored by said restoring unit to a server connected to an internal network (column 17, lines 8-64; column 18, lines 10-64).

Regarding **claim 14**, Yoshida discloses the electronic mail receiving apparatus, as set forth in claim 13, further comprising:

a destination recognition unit for recognizing a destination of the electronic mail data based on said electronic mail data restored by said restoring unit (column 14, lines 37-65; column 18, lines 1-39; column 23, lines 5-65); and

a notification unit for notifying the sender if the destination recognized by said destination recognition unit is not in said internal network (column 34, lines 39-65).

Regarding **claim 15**, Yoshida discloses an electronic mail communication system, comprising:

an Internet-connected transmission mail server; a transmission client connected to the transmission mail server to instruct transmission of electronic mail, and a transmission agent connected to a switched line to function as a client to the transmission mail server (fig. 1, items 1-3, 1-5; column 8, lines 36-67),

wherein said transmission client outputs, to said transmission mail server, electronic mail data that includes a description of a destination of said transmission agent and a description of a final mail destination (column 14, lines 37-65; column 18, lines 1-39); and

wherein said transmission agent retrieves electronic mail data in which the destination of the transmission agent is described by said transmission client from said transmission mail server and transmits the electronic mail data using facsimile communication procedures using the switched line (column 23, lines 34-67; column 17, lines 8-64; ).

Regarding **claim 16**, Yoshida discloses an electronic mail communication system for transmitting and receiving electronic mail information between an internal network on a sender side and an internal network on a receiver side (column 14, lines 37-65; column 18, lines 1-39), wherein

the internal network on the sender side comprises a transmission mail server, a transmission client for generating electronic mail information, and a transmission agent which is a client having a function for transmitting the electronic mail information via a switched line (column 23, lines 34-67; column 17, lines 8-64; fig. 1, items 1-3, 1-5, 1-6);

the internal network on the receiver side comprises a reception mail server, a reception client which is a final destination of the electronic mail information, and a reception agent which is a client having a function for receiving the electronic mail information via a switched line (fig. 1, items 1-9, 1-10, 1-6);

said transmission agent transmits an electronic mail message whose final destination is said reception client designated by said transmission client to said reception agent via said switched line (column 23, lines 34-67; column 17, lines 8-64);

said reception agent transfers said electronic mail received via said switched line to said reception mail server (column 14, lines 37-65; column 18, lines 1-39).

***Response to Arguments***

5. Applicant's Request for Reconsideration filed on 12/08/2005, has been carefully considered but is not deemed fully persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address Applicants' main points of contention.

A. Applicants submit that Yoshida fails to teach that electronic mail data originates in an electronic mail format. Instead, the invention in Yoshida receives a fax from a fax machine, relays the received fax to another fax machine via electronic mail, and faxes the fax to a third fax machine. Col. 3, lines 3-32. To this extent, the communication in Yoshida originates as a fax and not in an electronic mail format. In contrast, the present invention includes . . . " wherein said electronic mail data originates in an electronic mail format." Claim 1. As such, the electronic mail data of the claimed invention does not originate as a fax as does the communication in Yoshida, but rather originates in an electronic mail format. Thus the electronic mail data as included in the claimed invention is not taught by the communication of Yoshida, and Applicants respectfully request that the Office withdraw its rejection.

B. Applicant contends that with further respect to independent claims 1 and 9, Applicants respectfully submit that Yoshida also fails to teach that "said image form is adapted to be restored into electronic mail data in the electronic mail format" and similarly claimed in claim 13 as "a restoring unit for restoring said data received by said receiving unit into electronic mail data."

As stated above, Yoshida receives a communication via fax, relays the communication via electronic mail to a second fax machine, and faxes the relayed communication to a third fax machine. This is in contrast to the claimed invention in which electronic mail data originating in an electronic mail format is converted to an image form permitting facsimile communication, and transmitted by facsimile in a format that allows restoration into electronic mail data in an electronic mail format. Accordingly, Applicants request that the rejection be withdrawn.

6. As to "Point A" the examiner does not agree with the characterization of the "origin of the electronic mails as being in electronic format" as stated by the applicants. Applicants admit that the invention in Yoshida receives a fax from a fax machine, relays the received fax to another fax machine via electronic mail, and faxes the fax to a third fax machine and ... (Col. 3, lines 3-32) To this extent, the communication in Yoshida does not necessarily originate as a fax. Instead, the Examiner broadly interprets the origination at the electronic mail relay and at this point the communication is in an electronic mail format. In a relay system a point of origination is relative to which segment of the relay is being examine. By this rationale, rejection of the claims are sustained.

As to "Point B", Yoshida in column 18, lines 10-32 discloses

The electronic mail relay transmission mode means a mode in which the first relay station sends data to the destination in the electronic mail data format. The facsimile transmission mode means a mode in which the first relay station sends data to the destination in the facsimile data format.

The first relay station receives a facsimile via the ISDN or the PSTN, and sends an electronic mail via a private line or the Internet in such a way that the electronic mail facsimile machine 1-18 of the head office destination performs. The second relay station receives an electronic mail via a private line or the Internet, and sends a facsimile via the ISDN or the PSTN in such a way that the electronic mail facsimile machine 1-52 of the Paris branch office performs. Each of the first and the second relay stations must be an electronic mail facsimile machine.

The first relay station assigns the first relay station data 5-5, decides the second relay station according to the destination data 5-3, converts the facsimile data into the file format that can be sent by electronic mail, and sends the data. The telephone number indicated by the first relay station data 5-5 is used as a destination. By this rationale, the rejection of the claimed invention is sustained.

### **Conclusion**

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-9000.


Jude Jean-Gilles

Patent Examiner

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JJG 

February 17, 2006

  
DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100